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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,762	05/01/2001	Robert Shea	31910.000014	5008
23387	7590	02/06/2004		
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			EXAMINER JIMENEZ, MARC QUEMUEL	
			ART UNIT 3726	PAPER NUMBER 18
DATE MAILED: 02/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/846,762

Applicant(s)

SHEA ET AL.

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6,8-14 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6,8-14 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/16/04 has been entered.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 6, 8-14, and 27** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 8-14 recite "The roller assembly" in the first line of each claim. This limitation should read - -The roller- - because the invention is directed to a roller as recited in the preamble of claim 27. "The roller assembly" renders the scope of the claims indefinite because it is unclear whether the invention is directed to the roller assembly or to the roller.

It is unclear what previous claim that claim 13 is referring to.

Claim 27 recites "the nip" in line 11 which lacks proper antecedent basis.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 6, 8-11, and 27** rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrer (2,761,547) in view of Snelling (5,520,977).

Gehrer teaches a roller for a roller assembly as used in transporting a sheet material, the roller comprising: a shaft **1**, a first tire **2** mounted to the shaft **1** (col. 3, lines 45-47), the first tire **2** including a compliant core **6** fixed to the shaft **1** for rotation with the shaft **1**, and a non compliant outer layer **5** fixed to the core **1** for rotation with the core **1**, the circumference and diameter of the non compliant outer layer **5** remaining substantially constant (because it is made of steel, see col. 2, lines 61-64) as the outer layer rotates against an opposed surface to create the nip, and the compliant core **6** allowing radial displacement (col. 3, lines 3-18, “an eccentric relationship relative to each other”) of the outer layer relative to the shaft **1** as the outer layer **5** rotates against an opposed surface.

Gehrer teaches the invention cited with the exception of the compliant core composed of an open cell foam. It is noted, however, that Gehrer teaches that the compliant core **6** could be made of “rubber or any other suitable elastic and/or resilient substance”.

Snelling teaches a compliant core 13 made of an open cell foam (col. 4, lines 46-50).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrler with an open cell foam, in light of the teachings of Snelling, in order to provide a material capable of providing desirable compressibility characteristics, as suggested by Snelling at col. 4, lines 47-48 and as also suggested by Gehrler who teaches that the compliant core could be any other suitable elastic and/or resilient substance. Furthermore, It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Regarding claim 6, Snelling teaches that the cellular structure comprises polyurethane (col. 4, line 47).

Regarding claims 8-10, Gehrler inherently teaches a durometer between 35-60 Shore A because Gehrler uses the same material that applicant uses for the non-compliant layer, namely, a metal tube (col. 2, lines 61-64).

Regarding claim 11, Gehrler teaches that the non-compliant layer includes a metal tube (col. 2, lines 62-63).

6. **Claims 8-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrler in view of Snelling as applied to claim 27 above, and further in view of Lancaster (5,451,198).

Gehrler/Snelling teach the claimed durometers of the non-compliant layer because Gehrler

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teaches that the noncompliant layer is made of a metal tube which is the same material that applicant uses for the non-compliant layer (see for example claim 11 of applicant's disclosure).

Alternatively, Lancaster teaches a non-compliant layer having a durometer between 35 and 60 Shore A (col. 4, lines 3-5).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrler/Snelling with a non-compliant layer having a durometer between 35 and 60 Shore A, in light of the teachings of Lancaster, in order to provide a layer that has a better gripping surface. Furthermore, It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

7. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrler in view of Snelling as applied to claim 11 above, and further in view of Sawa et al. (5,553,845).

Gehrler/Snelling teach the invention cited with the exception of having a coefficient of friction enhancing material on the metal tube.

Sawa et al. teach a coefficient of friction (abstract, lines 1-2) enhancing material 7 on a tube 4.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrler/Snelling with a coefficient of friction enhancing

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material, in light of the teachings of Sawa et al., in order to provide a surface which has good friction and is not affected by changes in temperature or humidity as suggested by Sawa et al., see abstract, lines 1-3.

8. **Claim 13** is rejected, as best understood (because it is unclear which claim that claim 13 is dependent upon), under 35 U.S.C. 103(a) as being unpatentable over Gehrler in view of Snelling as applied to claim 27 above, and further in view of Eiji (EP 08169573).

Gehrler/Snelling teach the invention cited with the exception of using a plastic tube for the non-compliant layer.

Eiji teaches a layer of plastic **3b** over a foam layer **3a**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrler/Snelling with a plastic tube, in light of the teachings of Eiji, in order to provide a rust proof tube. Furthermore, It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331. It is noted that Gehrler teaches a metal tube which is what applicant claims in claim 11.

9. **Claim 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrler in view of Snelling and Eiji as applied to claim 13 above, and further in view of Sawa et al.

Gehrer/Snelling/Eiji teach the invention cited with the exception of having a coefficient of friction material on the plastic tube.

Sawa et al. teach a coefficient of friction (abstract, lines 1-2) enhancing material 7 on a tube 4.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrer/Snelling/Eiji with a coefficient of friction enhancing material, in light of the teachings of Sawa et al., in order to provide a surface which has good friction and is not affected by changes in temperature or humidity as suggested by Sawa et al., see abstract, lines 1-3.

#### ***Response to Arguments***

10. Applicant's arguments with respect to claims 6, 8-14, and 27 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Contact Information***

11. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies



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of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**. The examiner can normally be reached on **Monday-Friday, between 5:30 am- 2:00 pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

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Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>

  
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**MJ**  
February 4, 2004